The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KRAIG A. KIRSCHNER

Appeal No. 2006-1296
Application No. 10/759,873
Technology Center 3600

Decided: July 25, 2006

Before OWENS, BAHR and LEVY, *Administrative Patent Judges.*

BAHR, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1-3.

We AFFIRM and enter a NEW GROUND OF REJECTION.

BACKGROUND

The appellant's invention relates to a seismic adaptor for attachment to one beam of a steel web joist (present specification, p. 2). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relies upon the following as evidence of unpatentability:

Steinke	4,408,928	Oct. 11, 1983
Rebentisch	4,784,552	Nov. 15, 1988
Koyama	5,259,165	Nov. 9, 1993
Kirschner	US 6,749,359 B1	Jun. 15, 2004

Appellant's admitted prior art (AAPA), as represented by IDS filed Jul. 30, 2001 in parent Application No. 09/844,807 (issued as US 6,749,359), copy appended to examiner's answer (mailed September 19, 2005)

The following rejections are before us for review.

Claims 1-3 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of Kirschner in view of Rebentisch.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over AAPA in view of Koyama and Rebentisch.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over AAPA in view of Koyama, Rebentisch and Steinke.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding this appeal, we make reference to the examiner's answer for the examiner's complete reasoning in support of the rejections and to the appellant's brief (filed July 5, 2005) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the following determinations.

We turn our attention first to the obviousness-type double patenting rejection of claims 1-3. Claim 2 of the Kirschner patent recites all of the limitations of claims 1 and 3 of the present application, including each upstanding engagement portion being at an obtuse angle to the flat anchor portion, but does not expressly recite that the obtuse angle is "substantially greater than 90°." Claim 3 of the Kirschner patent likewise recites all of the limitations of claim 2 of the present application except for an express recitation of the obtuse angle being "substantially greater than 90°."

As explained in our new ground of rejection, *infra*, the present specification lacks sufficient guidance to permit one of ordinary skill in the art to ascertain the scope of the terminology "substantially greater than 90°" with the requisite certainty to satisfy the second paragraph of 35 U.S.C. § 112, thereby rendering claims 1-3 indefinite. We recognize the inconsistency implicit in our holding that claims 1-3 are rejectable under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention with a holding that these claims are unpatentable under the doctrine of obviousness-type double patenting. Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, a determination as to patentability under 35 U.S.C. § 103, or in this case obviousness-type double patenting, is not made. *See In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). However, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. *See Ex parte Ionescu*, 222 USPQ 537, 540 (Bd. App. 1984). For purposes of deciding the appeal of the obviousness-type double patenting

rejection, we interpret the language "an obtuse angle substantially greater than 90°" as used in claim 1 on appeal to be any obtuse angle, as obtuse angles are by definition angles greater than 90° and less than 180° and as appellant's specification provides no more specific definition of this obtuse angle.

With the above definition in mind, we find that the recitation of the "obtuse angle" in claim 2 of the Kirschner patent would have suggested "an obtuse angle substantially greater than 90°" and, consequently, conclude that the subject matter of claims 1-3 would have been obvious in view of claims 2, 3 and 2, respectively, of the Kirschner patent.[1] The obviousness-type double patenting rejection of claims 1-3 is thus sustained.

The rejections of claims 1 and 2 as being unpatentable over AAPA in view of Koyoma and Rebentisch and claim 3 as being unpatentable over AAPA in view of Koyoma, Rebentisch and Steinke, on the other hand, are not sustained. As more fully explained below, we find no suggestion in any of Koyoma, Rebentisch and Steinke to modify the AAPA arrangement to provide the engagement plate with upstanding portions being at an *obtuse* angle to the flat anchor portion.

The AAPA relied upon by the examiner includes an arrangement including a steel web joint beam with two angle elements, an anchor plate, an engagement plate and a stud essentially as recited in appellant's claims, wherein the anchor plate and engagement plate comprise square washers as illustrated on the page of the AFCON Flyer included with the IDS appended to the answer. Such washers lack the upstanding engagement portions called for in appellant's claims.

Even assuming that Koyama would have provided suggestion to modify the AAPA arrangement to provide upstanding engagement portions on the engagement plate, the examiner concedes that Koyama provides no teaching or suggestion of engagement portions being at an

[1] The examiner's application of Rebentisch is superfluous to this rejection.

obtuse angle substantially greater than 90° as called for in appellant's claims. The examiner relies on Rebentisch for such a suggestion.

Rebentisch describes a nut 10 for a channeled structural member, the nut having two parallel sharp edges 24 for engaging flanges 26 of the channeled structural member by gripping or biting into the flanges. The sharp edges 24 provide an improved gripping power preventing slipping of the nut 10 and the bolt 22 under load. Rebentisch provides no teaching with regard to securement arrangements for web joist beams comprising two angle elements and thus would have provided no suggestion to one of ordinary skill in the art to modify the engagement plate of the AAPA arrangement. Further, the modes of securement in the AAPA and Koyama arrangements are so vastly different from the biting gripping securement taught by Rebentisch that one skilled in the art would not have looked to the teachings of the Rebentisch nut to modify the engagement plate of the AAPA arrangement.

In light of the above, the rejection of claims 2 and 3 as being unpatentable over AAPA in view of Koyama and Rebentisch cannot be sustained. Inasmuch as the examiner's application of Steinke provides no cure for the deficiency of the combination discussed above, it follows that the rejection of claim 3 as being unpatentable over AAPA in view of Koyama, Rebentisch and Steinke also cannot be sustained.

NEW GROUND OF REJECTION

Pursuant to 37 CFR § 41.50(b), we enter the following new ground of rejection.

Claims 1-3 are rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the invention.

The term "substantially" is a term of degree. When a word of degree is used, such as the term "substantially" in claim 1, it is necessary to determine whether the specification provides some standard for measuring that degree. *See Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

Admittedly, the fact that some claim language, such as the term of degree mentioned *supra*, may not be precise, does not automatically render the claim indefinite under the second paragraph of 35 U.S.C. § 112. *Id.* Nevertheless, the need to cover what might constitute insignificant variations of an invention does not amount to a license to resort to the unbridled use of such terms without appropriate constraints to guard against the potential use of such terms as the proverbial nose of wax.

In *Seattle Box*, the court set forth the following requirements for terms of degree:

> When a word of degree is used the district court must determine whether the patent's specification provides some standard for measuring that degree. The trial court must decide, that is, whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification.

In this instance, the only discussion of the obtuse angle or the requirement that it be "substantially greater than 90°" appears on page 4 of the present specification. In particular, the specification states: "The upstanding engagement portions 30 and 32 form obtuse angles substantially greater than 90° as illustrated in Figure 3 with the flat anchor portion 26 with all being formed from the same plate." One skilled in the art would find no guidance in either this discussion in the specification or the illustration in Figure 3 as to the metes and bounds of the phrase "substantially greater than 90°." Claim 1 is therefore indefinite. Claims 2 and 3, which depend from claim 1, are likewise indefinite.

CONCLUSION

To summarize, the obviousness-type double patenting rejection of claims 1-3 is sustained, the rejections under 35 U.S.C. § 103 are reversed and a new rejection of claims 1-3 is entered.

Regarding the affirmed rejection(s), 37 CFR § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should the appellant elect to prosecute further before the examiner pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. § 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR § 41.50(b)

TERRY J. OWENS
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

STUART S. LEVY
Administrative Patent Judge

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